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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,342	12/12/2005	Dieter Schmidt	SCHM3012/FJD	3465
23364 7590 12/11/2007 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			EXAMINER LEVI, DAMEON E	
			ART UNIT 2841	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,342	<b>Applicant(s)</b> SCHMIDT ET AL.	
	<b>Examiner</b> Dameon E. Levi	<b>Art Unit</b> 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08/31/2007(RCE).
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, Applicant's submission filed on 08/31/2007 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamura et al US Patent 6020824.**

**Regarding claim 6,** Tamura et al discloses an assembly comprising:

a housing(element 10, Figs 1-35) for receiving a plurality of plug-in cards(element 50, Figs 1-35), a display unit(element 40, Figs 1-35);to which said plurality of plug in cards are connectable, said display unit comprising a frame(element 30, Figs 1-35) to which a display, a keypad(Fig 4) and a circuit board(element 20, Figs 1-35) can be connected, for forming a switchboard installable device, wherein conductive traces of said circuit board serve for the electric connection of said plurality of plug-in cards and

an adaptation module(element 30, Figs 1-35) connectable to said housing which serves for securement to the hat rail and which has a circuit board(element 20, Figs 1-35), whose conductive traces are laid-out correspondingly to the conductive traces of said circuit board of said display unit.

**Regarding claim 7**, Tamura et al discloses wherein on said circuit boards, card edge connectors(element 60, Figs 1-35) are provided, which are situated to be mutually fitted such that, on placement of either said adaptation module or said display unit onto said housing, the connections between said plurality of plug-in cards are produced.

**Regarding claim 8**, Tamura et al discloses wherein said circuit board has display operating electronics for said display(element 20, Figs 1-35).

**Regarding claim 9**, Tamura et al discloses wherein said adaptation module has two angle sheets(see ends of element 30, Figs 1-35), of which at least one is resiliently mounted to serve for a snap-in connection with the hat rail.

**Regarding claim 10**, Tamura et al discloses wherein said adaptation module comprises steel sheet(element 30, Figs 1-35).

**Regarding claim 11**, Tamura et al discloses wherein said plurality of plug-in cards include at least one of: a CPU-card, an I/O card, and power supply card (element 50, Figs 1-35).

### ***Response to Arguments***

Applicant's arguments in the Request for Continued Examination filed 08/31/2007 have been fully considered but they are not persuasive. Applicant's argues, "It appears that

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the examiner does not understand the distinction that was made in the RESPONSE filed with the RCE application on April 26, 2007. In that response it was noted that "[w]hen the adaptation module is used for attachment to the hat rail, the display unit is not used," and that claim 6 was amended "to state that the display unit has a display, a keypad and a circuit board which can be mounted with the display unit but not when the adaptation module is used." In his latest rejection the examiner discusses the Tamura et al. patent indicating that it has a housing, a plurality of plug-in cards, a display unit and an adaptation module. Nothing is said, however, about the distinction made that the display unit and adaptation module are not used together".

In response the Office deems the statements as amounting to a general allegation that the claims define a patentable invention. Although Applicants amends claim 6, to state, "a frame to which a display, a keypad and a circuit board can be mounted", this is merely deemed as an intended use of the frame, and hence the recitation of, "which a display, a keypad and a circuit board can be mounted" is deemed by the Office as not being positively recited and still falling within the scope of the art of record. The prior art of record is still relied upon as teaching or suggesting all of the structural elements of the claimed invention. Additionally, regarding the recitations throughout that an element is "capable of" (e.g. connectable) performing a function is not a positive limitation but only requires the ability to so perform. In this case, the prior art of record is deemed as at least possessing such ability. Furthermore, it has been held that a recitation with respect to the manner in which a claimed is intended to be employed(e.g. a frame to

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which a display, a keypad and a circuit board can be connected, for forming a switchboard installable device..." an adaptation module connectable to said housing which serves for securement to the hat rail") does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

This is a Request for Continuation of applicant's Application No. 10/537,342. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E. Levi whose telephone number is (571) 272-

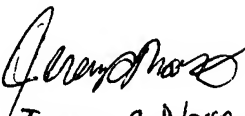
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2105. The examiner can normally be reached on Mon.-Thurs. (9:00 - 5:00) IFP, Fridays Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dameon E Levi  
Examiner  
Art Unit 2841

  
Jeremy C. Norris  
Patent Examiner  
Art Unit 2841

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